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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,276	08/22/2000	Kiyonobu Kojima	SONY-U0059	8667

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ALEXANDRIA, VA 22314

EXAMINER

DUONG, OANH L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,276

Applicant(s)

KOJIMA ET AL.

Examiner

Oanh Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-18 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/14/2005 has been entered.

Claim Objections

3. Claims 7 and 16 are objected to because of the following informalities: the program should comprise code(s) or instruction(s) instead of step(s). Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,757,657 in view of Shirai et al. (Shirai) (US 2001/0042093 A1) for the reason set forth below.

Regarding claim 1, claims 1 and 2 of the above patents recite:

a camera control for taking a picture;

a camera control means for controlling said camera to take a picture when a first predetermined operation is executed;

a microphone configured to recognize a voice;

a generating means for generating at least one of words or sentences corresponding to the recognized voice when said first predetermined operation is being executed:

a memory means for storing said picture and said at least one of words or sentences as a file of said picture, said at least one or words or sentences being stored at predetermined position in the file of said picture.

The claims of the above patent does not explicitly recite a file select means for executing a second predetermined operation to select a file of said picture and said at least one of words or sentences from said memory; and a transmission-information

creation means for creating transmission information for transmitting information of a predetermined file selected by said file selected means to a predetermined partner, wherein said transmission information is created when said predetermined file is selected in a batch operation when said second predetermined operation is executed.

Shirai teaches a mail sending apparatus wherein a file is attached to a mail message to form mail data. Shirai teaches a file select means for selecting a file (i.e., select a file, page 4 paragraph 76 lines 8-9); and transmission information creation means for creating transmission information for transmitting information of a predetermined file selected by said file select means to a predetermined partner, wherein said transmission information is created when said predetermined file is selected in a batch operation when said predetermined operation is executed (e.g., see page 4 paragraph 76, Shirai discloses transmission information such as email data or attached file is automatically generated when a file is selected).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the above patent to include the file select means and a transmission-information creation means as in Shirai. One would be motivated to do so to allow a file itself to be added to a mail message and thereby allowing email to be used very effectively (Shirai, paragraph 147 lines 7-8).

Claim 4 represents a method that is parallel to claim 1. Claim 4 does not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons.

Claim 7 represents a program that is parallel to claim 1. Claim 7 does not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5, 7-8, 10-11, 13-14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al (Shirai) (US 2001/0042093 A1) in view of Brais et al. (Brais) (US 5,995,936).

Regarding claim 1, Shirai teaches information transmission apparatus (Fig. 3) comprising:

a file select means for selecting a file (i.e., select a file, page 4 paragraph 76 lines 8-9); and

transmission information creation means for creating transmission information for transmitting information of a predetermined file selected by said file select means to a predetermined partner, wherein said transmission information is created when said predetermined file is selected in a batch operation when said predetermined operation

is executed (e.g., see page 4 paragraph 76, Shirai discloses transmission information such as email data or attached file is automatically generated when a file is selected).

Shirai does not explicitly teach a camera control means, a microphone, a generating means and a memory means as claimed.

Brais teaches system and method wherein voice and image information is automatically assembled into a file (see abstract), Brais teaches:

a camera for taking a picture (col. 12 lines 31-53);

a camera control means for controlling said camera to take picture when a first predetermined operation is executed (i.e., shutter click, col. 12 lines 45-49);

a microphone configured to recognize a voice (col. 10 lines 39-41);

a generating means for generating at least one of words or sentences corresponding to the recognized voice when said first predetermined operation is being executed (i.e., providing an association between prose and captured images via a coupling of the audio and image capture means, through recording of sound associated with image acquisition in form of a shutter click, col. 9 lines 25-30 and col. 12 lines 41-50);

a memory means for storing said picture and said at least one of words or sentences as a file of said picture (i.e., the text and digitized images are stored within a database wherein image have associated with annotations in the form of images, col. 6 lines 3-5), said at least one of words or sentences being stored at a predetermined position in the file of said picture (i.e., the text and digitized images are inserted in chronological order, col. 5 lines 65-66).

It would have been obvious to one having ordinary skill in the art at the time the invention to incorporate the a camera control means, a microphone, a generating means and a memory means of Brais in process of file transmitting in Shirai. One would be motivated to do so to allow a file including voice and image information to be automatically generated, thereby increasing the system flexibility (Brais, col. 5 lines 17-20).

Regarding claim 2, Shirai teaches picture-information transmission apparatus according to claim 1 wherein said transmission information is an electronic mail (page 2 paragraph 23).

Claim 4 represents a method that is parallel to claim 1. Claim 4 does not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons.

Regarding claim 5, Shirai teaches a picture-information transmission method according to claim 4 wherein said transmission information is an electronic mail (page 2 paragraph 23).

Claim 7 represent a program that is parallel to claim 1. Claim 7 does not teach or define any new limitation above claim 1 and therefore is rejected for similar reasons.

Regarding claim 8, Shirai teaches a program storage medium according to claim 7 wherein said transmission information is an electronic mail (e.g., Shirai, page 2 paragraph 23).

Regarding claim 10, Shirai teaches a transmission apparatus (Fig. 3) comprising:

a file select means for selecting a file (i.e., select a file, page 4 paragraph 76 lines 8-9); and

transmission information creation means for creating transmission information for transmitting information of a predetermined file selected by said file select means to a predetermined partner, wherein said transmission information is created when said predetermined file is selected in a batch operation when said predetermined operation is executed (e.g., see page 4 paragraph 76, Shirai discloses transmission information such as email data or attached file is automatically generated when a predetermined file is selected).

Shirai does not explicitly teach a camera control means, a microphone, a generating means and a memory means as claimed.

Brais teaches system and method wherein voice and image information is automatically assembled into a file (see abstract), Brais teaches:

a camera for taking a picture (col. 12 lines 31-53);

a camera control means for controlling said camera to take picture when a first predetermined operation is executed (i.e., shutter click, col. 12 lines 45-49);

a microphone configured to recognize a voice (col. 10 lines 39-41);
a generating means for generating at least one of words or sentences corresponding to the recognized voice when said first predetermined operation is being executed (i.e., providing an association between prose and captured images via a coupling of the audio and image capture means, through recording of sound associated with image acquisition in form of a shutter click, col. 9 lines 25-30 and col. 12 lines 41-50);

a memory means for storing said picture and said at least one of words or sentences as a file of said picture (i.e., the text and digitized images are stored within a database wherein image have associated with annotations in the form of images, col. 6 lines 3-5), said at least one of words or sentences being stored at a predetermined position in the file of said picture (i.e., the text and digitized images are inserted in chronological order, col. 5 lines 65-66).

Brais discloses a digital camera (col. 7 lines 63). It will be recognized by those of skill in the art that the digital camera includes means for activating a still-picture viewing program in which a still picture is viewed in a window on a display of the digital camera in order to allow user to review and delete unwanted pictures, and thereby increasing available memory for taking picture(s).

I It would have been obvious to one having ordinary skill in the art at the time the invention to incorporate the a camera control means, a microphone, a generating means and a memory means of Brais in process of file transmitting in Shirai. One would be motivated to do so to allow a file including voice and image information to be

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automatically generated, thereby increasing the system flexibility (Braiss, col. 5 lines 17-20).

Regarding claim 11, Shirai teaches a picture-information transmission apparatus according to claim 10 wherein said transmission information is an electronic mail (e.g., Shirai, page 2 paragraph 23).

Claim 13 represents a method that is parallel to claim 11. Claim 13 does not teach or define any new limitation above claim 11 and therefore is rejected for similar reasons

Regarding claim 14, Shirai teaches a picture-information transmission method according to claim 13 wherein said transmission information is an electronic mail (e.g., Shirai, page 2 paragraph 23).

Claim 16 represents a program that is parallel to claim 10. Claim 16 does not teach or define any new limitation above claim 10 and therefore is rejected for similar reasons.

Regarding claim 17, Shirai teaches a program storage medium according to claim 16 wherein transmission information is an electronic mail (e.g., Shirai, page 2 paragraph 23).

6. Claims 3, 6, 9, 12, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai in view of Brais in further view of Watanabe et al. (Watanabe) (US 2003/0115277 A1).

Regarding claim 3, Shirai teaches a picture-information transmission apparatus according to claim 2.

The combination of Shirai and Brais does not explicitly teach transmission information as claimed.

Watanabe teaches system wherein image transmission via electronic mail is carried out more easily. Watanabe teaches information is created so that said at least one of words or sentences constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time the invention incorporate the transmission information of Watanabe in the process of generating transmission information of Shirai and Brais. One would be motivated to do so to allow an electronic mail with an image attached thereto to be transmitted so that exchange of images via electronic mail can be carried out easily and at low cost (Watanabe, page 1 paragraph 10).

Claim 6 represent transmission information that is parallel to claim 3, claim 6 does not teach or define any new limitation above claim 3 and therefore is rejected for similar reasons.

Claim 9 represent transmission information that is parallel to claim 3, claim 9 does not teach or define any new limitation above claim 3 and therefore is rejected for similar reasons.

Claim 12 represent transmission information that is parallel to claim 3, claim 12 does not teach or define any new limitation above claim 3 and therefore is rejected for similar reasons.

Claim 15 represent transmission information that is parallel to claim 3, claim 15 does not teach or define any new limitation above claim 3 and therefore is rejected for similar reasons.

Claim 18 represent transmission information that is parallel to claim 3, claim 18 does not teach or define any new limitation above claim 3 and therefore is rejected for similar reasons.

Response to Arguments

7. Applicant's arguments filed 06/13/2005 have been fully considered but they are not persuasive.

In the remarks, applicants argued in substance that:

(A) Prior art fails to teach or suggest at least one of word or sentences corresponding to the recognized voice is generated when the first predetermined operation is being executed.

As to point (A), Brais does teach at least one of word or sentence corresponding to the recognized voice is generated when the first predetermined operation is executed (i.e., providing an association between prose and captured images via a coupling of the audio and image capture means, through recording of sound associated with image acquisition in form of a shutter click, col. 9 lines 25-30 and col. 12 lines 41-50).

(B) Prior art fails to teach or suggest said transmission information is created wherein said predetermined file is selected in a batch operation when said second predetermined operation is executed.

As to point (B), Shirai does teaches transmission information is created wherein said predetermined file is selected in a batch operation when said second predetermined operation is executed (e.g., page 4 paragraph 76, Shirai discloses

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transmission information such as email data or attached file is automatically generated when a file is selected).

(C) Prior art does not teach memory means.

As to point (C), Prior art does teach memory means. For example, Brais teaches a memory means for storing said picture and said at least one of words or sentences as a file of said picture (i.e., the text and digitized images are stored within a database wherein image have associated with annotations in the form of images, col. 6 lines 3-5), said at least one of words or sentences being stored at a predetermined position in the file of said picture (i.e., the text and digitized images are inserted in chronological order, col. 5 lines 65-66).

As a result, the cited prior art does disclose picture-information transmission apparatus and method as broadly claimed by the applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 2:00PM - 10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D
August 1, 2005



SALEH NAJJAR
PRIMARY EXAMINER